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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

GREENE, DANIEL L

ART UNIT PAPER NUMBER

3621

DATE MAILED: 10/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/834,944	ENTANI, NARUTOA	
	Examiner	Art Unit	
	Daniel L. Greene	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>2/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 16 - 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kazmierczak et al. U.S. Patent 5,764,762 [Kazmierczak], and further in view of Iwamura U.S. Patent 6,144,946 [Iwamura].**

As per claim 16:

Kazmierczak discloses:

a management terminal apparatus for enciphering and selling a right of use of a literary work to a customer through a communication circuit, Col. 4, lines 24-42.

enciphering and transmitting use right frequency information for limitation of at least one of the number of times of use, the hour of use and the amount of use of the literary work to one of said customer terminal apparatuses, Col. 14, lines 50-67.

imposing a royalty for the literary work through the communication circuit in accordance with the number of times indicated by the use right frequency information; Col. 4, lines 25-67.

a literary work provider terminal apparatus for enciphering and distributing the literary work to a customer through the communication circuit; Col. 4, lines 24-42

wherein each of said one or more customer terminal apparatuses comprise:
a storage section for storing enciphered literary work data distributed thereto
from said literary work provider terminal apparatus, Fig. 1.

deciphering means for deciphering the enciphered literary work data and right of
use of the literary work data stored in said storage section, Col. 7, lines 1-30.

a playback circuit for playing back the deciphered literary work data; Fig. 1, **CPU**
wherein said deciphering means comprises a use right frequency information
storage memory provided therein for storing the use right frequency information
deciphered by said deciphering means in such a manner that the deciphered use right
frequency information cannot be referred to from the outside; Col. 11, lines 3-60.

wherein said deciphering means refers to the use right frequency information
stored in said use right frequency information storage memory to read out the
enciphered literary work data from said storage section and signals the read out literary
work data to said playback circuit. Col. 11, lines 3-67.

Kazmierczak discloses the claimed invention except for specifically detailing the
use right frequency information for limitation of at least one of the number of times of
use, the hour of use and the amount of use of the literary work. It would have been
obvious to one having ordinary skill in the art at the time of the invention was made to
include in the charge for the use of a literary work, use right frequency information for
limitation of at least one of the number of times of use, the hour of use and the amount
of use of the literary work, since it is known in the art that that charging for the use of
data can include some measure of use be it at least one of the number of times of use,

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the hour of use and the amount of use of the literary work. Further, Kazmierczak further does not expressly show use right frequency information for limitation of at least one of the number of times of use, the hour of use and the amount of use of the literary work. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The charging and collecting steps would be performed the same regardless of the rate charge schedule. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to collect from a customer a charge based upon use right frequency information for limitation of at least one of the number of times of use, the hour of use and the amount of use of the literary work a letter to the customers having any type of content, because such charge rates do not functionally relate to the steps in the method claimed.

Kazmierczak discloses the claimed invention except for the use frequency charges. Iwamura teaches that it is known in the art to provide for use frequency charges. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the transaction/purchase method of Kazmierczak with the use frequency procedure of Iwamura, in order to provide a method for the payment schedule of the literary use.

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As per claim 17:

Kazmierczak discloses the claimed invention except for wherein said deciphering means updates the use right frequency information stored in said use right frequency information storage memory in response to the number of times of playback by said playback circuit.

It would have been obvious to one having ordinary skill in the art at the time of the invention was made to wherein said deciphering means updates the use right frequency information stored in said use right frequency information storage memory in response to the number of times of playback by said playback circuit since it is known in the art that wherein said deciphering means updates the use right frequency information stored in said use right frequency information storage memory in response to the number of times of playback by said playback circuit is done to track the usage.

As per claim 18:

Kazmierczak discloses the claimed invention except for wherein each of said one or more customer terminal apparatuses operates in response to the use right frequency stored in said use right frequency information storage memory such that, when the use right frequency is higher than "0", the enciphered literary work data stored in said storage section can be read out and deciphered by means of said deciphering means and then the deciphered literary work data can be signaled to and played back by said playback circuit, but when the use right frequency is "0", the decipherment by said

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deciphering means is not performed and the enciphered literary work data cannot be played back. However, Kazmierczak does disclose processing the usage data. Fig. 7.

It would have been obvious to one having ordinary skill in the art at the time of the invention was made to wherein each of said one or more customer terminal apparatuses operates in response to the use right frequency stored in said use right frequency information storage memory such that, when the use right frequency is higher than "0", the enciphered literary work data stored in said storage section can be read out and deciphered by means of said deciphering means and then the deciphered literary work data can be signaled to and played back by said playback circuit, but when the use right frequency is "0", the decipherment by said deciphering means is not performed and the enciphered literary work data cannot be played back since it is known in the art that when the paid for usage is exhausted/used up, access is denied.

As per claim 19:

Kazmierczak does not expressly show wherein the literary work is music data. However, Kazmierczak does teach about the distribution and control of data packages. Col. 1, lines 8-16. The differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The encrypting, distribution and accounting steps would be performed the same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to provide encrypted data to a customer be it music, video, literature, etc., because such data does not functionally relate to the steps in the method claimed.

As per claim 20:

Kazmierczak further discloses:

A recording medium on which a control program for causing a computer to implement the functions of the literary work distribution network system as claimed in claim 16 is recorded. Col. 4, lines 30-45.

Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant.

Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Conclusion

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

4. Kupka et al. U.S. Patent 6,434,535. Teaches about encrypted electronic content that can only be accessed from a particular piece of media.
5. Frison et al. U.S. Patent 6,049,789. Teaches about the software pay-per-use licensing system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel L. Greene whose telephone number is 703-306-5539. The examiner can normally be reached on M-Thur. 8am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on 703-305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

7/29/2004

DLG


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